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CHARLES ELMORE

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,
Respondents.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals for the Second Circuit.

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INDEX.

Opinions 1

Jurisdiction 1

Statute Involved 2

Questions Presented 2

Specification of Errors to be Uurged 2

Summary Statement of the Matter Involved 4

Reasons for Granting the Writ 6

(A) There is diversity of decision here between (and within) Circuit Courts of Appeals on the same matter.

(1) The decision of the Court below:

(a) that Patent No. 1,605,445 "was entitled to the *narrowest* of all equivalents," is in direct conflict with the decision of the United States Court of Appeals for the Eighth Circuit in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320, which held that "(the patent is entitled) to a broad range of equivalents approaching that accorded to a *pioneer* invention,"— and with *its own* decision in the case of Stevens v. Carl Schmid, Inc., 73 F. (2d) 54, where the same patent was held valid and infringed;

(b) that Patent No. 1,605,445 "can be thought to have been *an invention at all*" is in direct conflict with said decision of the United States Court of Appeals in Dean Rubber Mfg. Co. v. Killian, that "The machine of the patent (1,605,445) is * * * a *pioneer* invention," and

(c) is in direct conflict with the decision of the United States Court of Appeals for the Seventh Circuit in the case of E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. (2d) 63, 66, on the issue of whether it is presumed that knowledge of the prior art was possessed by workers in the art other than the inventor 6-7

As to the Bead Roller Patent No. 1,605,445 7

As to the Distributing Patent, No. 2,128,827 11

(2) The decision of the Court below is in conflict with the decision of the Court of Appeals for the Sixth Circuit on the issue of whether a patent in suit may be invalidated by a "paper" patent which was not conceived, disclosed, adaptable by obvious and well-known expedients, or adapted, to accomplish the ends of the patent in suit 16

(B) Important Questions of Patent Law Have Been Decided in a Manner Which is in Conflict With Applicable Decisions of This Court 18

(1) The decision here ignores the test of invention based on the standard of something more than could be accomplished by the "mechanic skilled in the art" which is the rule in this Court, and by substituting the standard of something more than could be accomplished by another "inventor," the decision below sets up an impossible standard. *If allowed to stand, the decision here would inevitably invalidate, in the Second Circuit, every patent regardless of its merit.* 18

(2) The decision of the Court below is in conflict with this Court's interpretation of Rule 52(a) of the Federal Rules of Civil Procedure 20

(3) The Court below, in disregarding the well-established History Test applied by this Court and other Courts in determining the issue of invention, has misapprehended the purport of this Court's recent patent decisions 23

Conclusion and Prayer 29

Appendix. 35 U. S. C. 31; R. S. 4886. Inventions patentable 30

TABLE OF AUTHORITIES.

Cases.

Acadian v. Land, 153 F. (2d) 151 (C. A. 5) 22

Altoona Publix Theatres v. Tri-Ergon Corp., 294 U. S. 477 24

Bozarjian v. Woods, 175 F. (2d) 483 (C. A. 1) 22

Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403 .....14, 16

Carson v. American Smelting & Refining Co., 4 F. (2d) 463 (C. A. 9) 17

Consolidated Valve Co. v. Crosby Valve Co., 113 U. S. 157; 141 U. S. 441 19

Crest Specialty v. Trager, ... U. S. .... 95 L. Ed. 532 (advance sheets) 27

Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84 24

Davies v. Lahann, 145 F. (2d) 656 (C. A. 10) 22

Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316 (C. A. 8) 6, 8

Detrola Corp. v. Hazeltine Corp., 313 U. S. 259 24

Dow Chemical Co. v. Haliburton Oil Well Cementing Co., 324 U. S. 320 24

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45 24

Falkenberg v. Bernard Edward Co., 175 F. (2d) 427 (C. A. 7) 22

Franz v. General Motors, 176 F. (2d) 80 (C. A. 3) 22

Goodyear Tire & Rubber Co. Inc. et al. v. Ray-O-Vac Co., 321 U. S. 275 .....24, 25

Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271 .....20, 24, 25, 27

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U. S. 605 .....9, 19

Great Atlantic & Pacific Tea Co. v. Jones, 177 F. (2d) 166 (C. A. 4) 22

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147 27

Hildreth v. Mastoras, 257 U. S. 27 24

Hobbs v. Beach, 180 U. S. 383 19

Hutzler Bros. Co. et al. v. Sales Affiliates, Inc., 164 F. (2d) 260 (C. A. 4) 16

Interchemical Corp. v. Sinclair & Carroll Co., Inc., 144 F. (2d) 842 25

Jungersen v. Baden et al., 166 F. (2d) 807 26

Landis Machine Co. et al. v. Parker-Kalon Corp., et al., 90 USPQ 129 15

Mumm v. Decker, 301 U. S. 168 15

Pointer v. Six Wheel, 177 F. (2d) 153 (C. A. 9) 22

Powers-Kennedy Co. v. Concrete Co., 282 U. S. 175 ... 24

Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc., 293 U. S. 1 15

Safety Car Heating and Lighting Co. v. General Electric Co., 155 F. (2d) 937 24

Seymour v. Osborne, 11 Wall. 516 17

Sinclair & Carroll Co. Inc. v. Interchemical Corp., 325 U. S. 327 ..... 18, 24, 25

Stevens v. Schmid, Inc., 73 F. (2d) 54 ..... 6, 8

Trabon v. Dirkes, 136 F. (2d) 24 (C. A. 6) 16, 17

Trico v. Delman, 180 F. (2d) 529 (C. A. 8) 22

United States v. Dubilier Condenser Corp., 289 U. S. 178 24

Universal Oil Co. v. Globe Co., 322 U. S. 471 24

Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. (2d) 63 ..... 7, 13

Wahl v. Andis, 66 F. (2d) 162 (C. A. 7) 16

Wallings v. General Industries, 155 F. (2d) 711 (C. A. 6), aff. 330 U. S. 545 22

Williams v. United Shoe Mach. Corp., 121 F. (2d) 273 (C. A. 6), 316 U. S. 364 ..... 16, 24

Youngs Rubber Corporation v. Allied Latex Corporation, 188 F. (2d) 945 (C. A. 2) 5, 23, 27

Statutes.

Federal Food, Drug and Cosmetics Act (21 U. S. C. 301 *et seq.*) 5

Judicial Code, Section 240(a), as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Section 1254(1)) 1

35 U. S. C. 31; R. S. 4886 ..... 2, 19, 29, 30

Rules.

Federal Rules of Civil Procedure, Rule 52(a) 3, 20, 22

Rule 38, Section 5(b) of the Supreme Court of the United States 1

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OCTOBER TERM, 1951.

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FRANK B. KILLIAN & COMPANY,
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vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Frank B. Killian & Company, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the above entitled case.

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

OPINIONS.

The Opinion of the District Court (R. 806-813) is reported at 94 F. Supp. 281. The Opinion of the Court of Appeals (R. 824-831) is reported at 188 F. (2d) 940.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Section 1254(1)) and under Section 5(b) of Rule 38 of this Court.

The Opinion of the Court of Appeals is dated April 30, 1951 (R. 824). Petition for Rehearing or Remand (R. 833) was filed on May 15, 1951, and was denied on May 23, 1951 (R. 846).

STATUTE INVOLVED.

The Statute relied on is 35 U. S. C. 31; R. S. 4886 and the pertinent part thereof is reproduced in the appendix.

QUESTIONS PRESENTED.

1. Whether Patent No. 1,605,445 is valid and infringed.

2. Whether Patent No. 2,128,827 is valid.

3. Whether the present criteria of patentable invention are to be superseded from now on in the Second Circuit by a novel set of criteria formulated and advanced for the first time by the Court below as to:

(a) the test of "mechanic skilled in the art,"

(b) the presumption that workers in the art knew the disclosures of patents from their issuance, and

(c) the invalidating effect of "paper" patents.

4. Whether the Court below has correctly stated and followed the patent law as declared by this Court.

SPECIFICATION OF ERRORS TO BE URGED.

The Court of Appeals erred:

(1) In reversing the judgment of the District Court by holding Patent No. 1,605,445 not infringed.

(2) In reversing the judgment of the District Court by holding Patent No. 2,128,827 invalid.

(3) In holding that a patent on an invention which has been used by the entire industry for many years and has never been displaced is invalidated by a prior "paper" patent, which was incapable of doing:

(a) what the patent in suit actually did commercially or

(b) even what the "paper" patent was intended to do.

(4) In violating Rule 52(a) of the Federal Rules of Civil Procedure by reversing and disregarding Findings of Fact of the Trial Court without any showing that they were clearly erroneous and by failing to make allowance for the advantages possessed by the Trial Court that had observed demonstrations, viewed motion pictures, listened to conflicting testimony and passed on the credibility of witnesses.

(5) In holding that, with certain changes, "the Dutch machine could have been substituted for the patent in suit * * *" contrary to the finding of the Trial Court that, notwithstanding such changes, a "worthless product" would result.

(6) In holding, without support in the record and contrary to the findings of the Trial Court that "Stop the 'process' (of the Dutch patent) at two immersions and a 'prophylactic' results * * *." and "All that was needed was to stop the repetition of the 'process' of imposing 'layer upon layer of latex' at the right thickness."

(7) In holding without support in the record and contrary to the findings of the Trial Court, that a United States patent which is for a new combination of elements having a new mode of operation and for a new method and which gives a new result may be invalidated on a prior foreign "paper" patent disclosing a different combination of elements with a different mode of operation and a different method and giving a different result, which if used in an effort to produce the product of the United States patent would make a worthless article.

(8) In holding that a United States patent for a method and machine, which superseded the prior art and was adopted before the patent issued and has been used by the entire industry ever since for automatically, rapidly,

continuously and without the intervention of the human hands making from liquid latex in a combination of steps finished, ready to use, rubber articles in the form of tissue-thin, tubular sheaths weighing about 1/20 ounce, which meet the rigid inspection requirements of the United States Food & Drug Administration under the Federal Food, Drug and Cosmetic Act is invalidated by a foreign "paper" patent on a machine which was devised to make balls of raw, uncured rubber weighing from 20 to 40 pounds from latex and which at the very most and after several changes in structure, inspired by the U. S. patentee, would nevertheless produce only a "worthless" article as found by the Trial Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Petitioner, Frank B. Killian & Company, is a partnership owning the entire right, title and interest in and to Killian Patent No. 1,605,445 issued November 2, 1926, and Killian Patent No. 2,128,827 issued August 30, 1938.

This action is brought by petitioner for reversal of the decision of the Court of Appeals for the Second Circuit which held the foregoing patents invalid, and for reinstatement of the decision of the United States District Court for the Southern District of New York (Bondy, *J.*) which held that both patents were valid and had been infringed.

These two Killian patents cover important steps in the manufacture of thin dipped rubber articles, including prophylactics. The first of these patents (R. 611) is for a machine for performing the operation of rolling rings at the open ends of such articles to strengthen them against tearing when stretched. The second patent (R. 617) is for a method of, and apparatus for, performing all the operations necessary to convert latex into such articles in ready-to-use condition, including the step of picking up and distributing the latex on a form shaped like the desired article. The Youngs Rubber Corporation has manufactured rubber prophylactics by use of the Killian inventions under licenses

ever since before these Killian patents were issued and has paid royalty therefor continuously since 1924.

Rubber prophylactics, such as are made by use of the inventions of these two Killian patents, are the articles which are tested for the presence of holes by the Youngs Patents Nos. 2,213,113 and 2,244,591 owned by the Youngs Rubber Corporation. This testing is to avoid violation of the Federal Food, Drug and Cosmetics Act (21 U. S. C. 301 *et seq.*) as administered by the Federal Food and Drug Administration.

Those Youngs patents are involved in the companion case of *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945 (C. A. 2) in which a Petition for Certiorari is being filed concurrently herewith.

The patentee devised the inventions of the patents in suit and developed them by his own labor in his own small plant and at his own risk and expense. The inventions, by drastically decreasing the unit cost of production, enabled the users thereof to make and sell their goods at the same low price for 19 years, while labor and machinery costs were multiplying. The patentee and his partner granted licenses to all comers at a low royalty rate.

The devices of both patents promptly displaced previously used apparatus and have been widely used by manufacturers in the industry, with the payment of large sums as royalty therefor. Indeed the invention of the earlier patent has been used by the entire rubber prophylactic industry since 1925 and that of the later one by the entire latex prophylactic industry since 1932 (R. 18, 21), and neither of the inventions has ever been superseded.

No manufacturer other than the respondents has infringed upon either of these patents without suffering an injunction after trial.

The respondents entered the field with full knowledge of these patents and the litigation in which they had been

involved and appropriated these two inventions as well as the inventions of the two aforesaid Youngs patents.

There is no suggestion in the Record that the respondents did any developmental work of their own or otherwise independently arrived at the ideas embodied in the machines herein alleged to infringe.

The only issues raised by the respondents are validity and infringement. There is no suggestion that the patents have been misused; that proffered license agreements have been in any way onerous, unreasonable or restrictive; that any part of the industry has been unable to afford or in fact been deprived of the advance in technology represented in these patents; or that the petitioner has been associated with any other type of reprehensible conduct which might affect the right to equitable relief in a patent suit.

REASONS FOR GRANTING THE WRIT.

(A) There is diversity of decision here between (and within) Circuit Courts of Appeals on the same matter.

(1) The decision of the Court below:

(a) that Patent No. 1,605,445 "was entitled to the NARROWEST of all equivalents," is in direct conflict with the decision of the United States Court of Appeals for the Eighth Circuit in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320, which held that "(the patent is entitled) to a broad range of equivalents approaching that accorded to a PIONEER invention,"—and with ITS OWN decision in the case of Stevens v. Carl Schmid, Inc., 73 F. (2d) 54, where the same patent was held valid and infringed.

(b) that Patent No. 1,605,445 "can be thought to have been AN INVENTION AT ALL" is in direct conflict with said decision of the United States Court of Appeals in Dean Rubber Mfg. Co. v. Killian, that "The machine of the patent (1,605,445) is * * * a PIONEER invention," and

(c) is in direct conflict with the decision of the United States Court of Appeals for the Seventh Circuit in the case of E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. (2d) 63, 66, on the issue of whether it is presumed that knowledge of the prior art was possessed by workers in the art other than the inventor.

These three conflicts should be resolved by this Court since they are important in the adjudication of patents generally, including both patents No. 1,605,445 and No. 2,128,827 here involved, without regard to the fact that the earlier of these patents has expired.

As to the Bead Roller Patent No. 1,605,445, the Trial Court held it valid, saying:

> "Patent No. 1,605,445 is for a machine for the manufacture of uniform annular beads on the open end of thin rubber tubular articles. The machine of this patent was the first to roll such beads. It went into immediate use throughout the industry and completely replaced the former method of rolling such beads by hand. It has never been replaced, though the patent expired more than six years ago. Plaintiff's competitors procured licenses and paid royalties thereunder.
>
> "The patent was issued after consideration by the Patent Office of Hadfield Patent No. 1,097,017 and Brubaker Patent No. 1,192,383, relied on by defendants as anticipations.
>
> "The patent was held valid and infringed in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316 (8th Cir.), cert. denied 308 U. S. 624; Stevens v. Carl Schmid, Inc., 73 F. (2d) 54 (2d Cir.), cert. denied 294 U. S. 721; and in the following unreported cases in the Eastern Division of the Northern District of Ohio: Stevens v. Stardant Rubber Co., Equity No. 2508, and Stevens v. Perfection Rubber Co., Equity No. 2507, both decided February 16, 1928; and Stevens v. J. L. Shunk Rubber Co., Equity No. 2213, decided December 21, 1927. Those courts sustained the patent after careful consideration of the Hadfield and Brubaker patents and evidence

> which was substantially the same as introduced at this trial. This court likewise concludes on the record before it that the patent is valid."

and held it infringed, saying:

> "The accused machines follow Killian and not Hadfield. Parts of the accused devices are mere mechanical equivalents of the Killian machine. In both machines the conveyor moves the form lengthwise of the rotating element while the forms are prevented from upward movement and are directly engaged with the friction member which rotates them at a uniform rate of speed. In both machines beads are rolled on the open end of thin dipped rubber articles on the forms. In mode of operation and results defendants' accused bead roller is the same as the Killian device."

Despite its former holding of validity and infringement in *Stevens v. Schmid, Inc.*, 73 F. (2d) 54 the Court below now holds that "the invention, supposing it can be thought to have been an invention at all, was entitled to the narrowest of all equivalents." (R. 827.)

In line with that prior decision of the Court below and in contrast with the present decision of that Court, the Court of Appeals for the Eighth Circuit in *Dean Rubber Mfg. Co. v. Killian*, 106 F. (2d) 316, 320, held that:

> "The machine of the patent is * * * a *pioneer** invention."

and

> "(The patent is entitled) to a *broad* range of equivalents approaching that accorded to a pioneer invention."

When Patent No. 1,605,445 reached the Court below in this case, it had been held valid and infringed three times by the late Judge Westenhaver, twice by Judge Bondy, once by Judge Reeves and once each by the Courts of Appeals for the Second and Eighth Circuits with certiorari

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* Emphasis throughout this Petition is ours unless otherwise stated.

denied in both cases. All the judges who decided these cases were long experienced and highly skilled in patent law. The sound reasoning and law on which this patent was unanimously sustained in all those cases were then, and, we submit, are still, the reasoning and law in this Court.

The Court below held non-infringement *solely* on the ground that the claims of the patent recited *a* brush and the accused device had *two* brushes. This holding that the accused device is outside of the *scope of the patent* is contrary to the basic principle of patent law stated by this Court in its decision in the case of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605, as follows:

> "If accused matter falls clearly within the claim, infringement is made out and that is the end of it." (p. 607)
>
> "The theory on which it (the doctrine of equivalents) is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape' " (p. 608).

It is undeniable that every element of the claims of Patent No. 1,605,445 in suit is present in respondents' bead roller as clearly appears from plates 3 and 7 of Ex. 6 (R. 643, 647). Moreover, the proof shows that the accused bead roller "performs substantially the same function in substantially the same way to obtain the same result" as the patented bead roller and that "the two devices do the same work in substantially the same way, and accomplish the same result." (R. 122-123.) *Linde v. Graver*, 339 U. S. 605, 608.

The addition of a "functionless" roller to the teaching of Patent No. 1,605,445 (which is all that the respondents did as found by the Trial Court), does not avoid infringement. The Court below in holding the contrary appears to be sanctioning "a fraud on a patent"—*Graver v. Linde*, 339 U. S. 605, 608.

In the present case the Court below did not attempt to show that any of the prior decisions on *validity* was wrong in any respect whatever. Indeed, the Court quoted with approval Judge Westenhaver's holdings that he thought the device disclosed by the Hadfield patent "would not have operated," that "With all the industry needing and calling for the Killian apparatus, all manufacturers continued for fourteen years using hand labor, wholly uninfluenced by the existence of Hadfield" (R. 825), and that Hadfield did not " 'enrich the art' " (R. 827).

In the light of the foregoing facts, it is indeed astounding that the Court below could hold, as it did, that

> "the invention, supposing it can be thought to have been an invention at all, was entitled to the narrowest of all equivalents." (R. 827.)

But the decision is no more astounding than the manner in which it was reached. The Court reached that decision by the simple expedient of ignoring history and, on an assumption unsupported by the record and contradicted by logic, following a rule without precedent in any other Court, which it variously stated as follows:

> "The fact that the art has not profited by them (paper patents) is irrelevant unless it also appears that they were generally known; * * *" [he, the patentee must show] "that the art in fact knew the earlier steps, already taken"; (R. 826)—"* * * he must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware." (R. 831.)

This unprecedented rule was also applied to invalidate Patent No. 2,128,827.

> "As in the case of Hadfield's patent, we should have to be satisfied that the Dutch machine had been widely known in the art," (R. 831).

As to the Distributing Patent, No. 2,128,827, the Trial Court held it valid, saying:—

"Killian Patent No. 2,128,827 is for a method and apparatus for manufacturing automatically, rapidly, continuously and without the intervention of human hands complete and ready to use thin dipped rubber goods such as prophylactics. The steps in the method disclosed were automatically forming a film of latex of desired thickness in its various parts, rolling a bead on the open end of the film, curing the film, dusting the article and removing the dusted article from the form ready for use." (R. 809.)

"What Killian accomplished, and what the art did not have until he appeared with his invention, was the removal of a considerable quantity of latex from a bath on a form and transportation thereof away from the bath while retaining it and distributing it on the form and while causing the latex to set in the distributed position, controlling the distribution of latex on the form by simultaneously rotating and oscillating the form and providing a continuous process for making dipped rubber goods such as prophylactics from latex and making a machine which can do continuously and automatically and rapidly what had previously been done step by step with the aid of manual labor. This involved invention. See Goodyear Co. v. Ray-O-Vac Co., 321 U. S. 275, 279; Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 63; Hildreth v. Mastoras, 257 U. S. 27, 34; Expanded Metal v. Bradford, 214 U. S. 366; Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320." (R. 810-811.)

"Latex prophylactic makers in this country adopted the Killian method and apparatus under license agreements and paid royalties thereunder." (R. 811.)

"The prior art relied on by defendants was cited by the Patent Office before granting the patent. The Dutch Patent No. 2002 and Williams Patent No. 1,180,-358 are the two prior art patents on which defendants mainly rely. The object of the Dutch invention was to make solid balls of crude rubber from latex, and involved the coagulation of the latex by means of smoke

or other volatile means. It was not designed for thin walled articles such as prophylactics. The stick on which the balls were formed did not oscillate above and below the horizontal. It was kept horizontal throughout its travel outside the latex bath. The Dutch disclosure can not be adapted, without changes in operation, to produce the Killian films. There is no proof that the Dutch Patent was ever put to use even to make crude rubber balls." (R. 811.)

The Court below made no attempt to show that any of the foregoing Findings of Fact of the Trial Court was clearly erroneous. Nor did the Court challenge either the reasoning or authorities relied on by the Trial Court. On the contrary, the Court below made the following Findings favorable to validity:

"Killian is entitled to whatever merit is due to the first person who satisfies a long existing need. Moreover, presumably he designed his machine from the ground up and without suggestion or cue; and we may well agree that, taken as a feat, that *displayed enough originality to support a patent.*

* * * * *

"It is true that the two machines (Killian and the Dutch patent) were not identical and their purposes were *widely different,* * * *" (R. 829).

"* * * he (Killian) did add the feature that, after a 'form' had been dipped in its bath of latex and had been raised back again to horizontal, it was raised, still rotating, above the horizontal, so as to insure a more uniform spread of latex. *The Dutch patent did not disclose that step* * * *." (R. 829.)

Nevertheless, the unprecedented rule, applied as stated above to invalidate the Bead Roller Patent, was again invoked by the Court to invalidate this Distributing Patent. (R. 831.)

In invalidating both patents on the presumption (c) (*supra,* p. 7), that workers other than the inventor were

ignorant of the prior patented art, the decision below is in direct conflict with that of the United States Court of Appeals for the Seventh Circuit in *E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties,* 116 F. (2d) 63, where it was held (p. 66) both as to a prior United States patent and as to a prior foreign patent, that other workers in the art

> "* * * will be presumed to have known of its disclosure *since its issue* * * *."

This contrary rule was evolved by the Court below on the theory that

(a) a patent is not used because it is unknown to workers in the art, and

(b) had such patent been known to workers in the art, it would promptly have been adapted to the purposes of the patent in suit.

It was error for the Court below to assume, as it did, that all workers in the art are ignorant of the entire patent literature. That assumption loses sight of the actualities, for industry generally keeps abreast of the patent literature and hordes of patent searchers are constantly at work in the Scientific Library and Search Room of the United States Patent Office, to aid industry in this endeavor. All patents, domestic and foreign, including "paper" patents, are constantly being examined there by these searchers and by them made known to their clients. The Court below not only shut its eyes to this well known fact, but to the contrary, without the slightest basis, took unwarranted judicial notice that it is "a most unlikely possibility" that either the U. S. patent to Hadfield or the Dutch patent "had been widely known in the art." The Court below went so far as to presume complete ignorance on the part of workers in the art, of the patent literature in their own field.

Patent disclosures are used whenever it is worth while to use them in our competitive system and the almost universal reason why patent disclosures are not used is

because they are impractical or inoperative, as illustrated by the Hadfield patent and Dutch patent in this case.

As his patent shows (R. 770), when he filed his application on an alleged bead roller, Hadfield lived in Akron, Ohio, then the center of the rubber industry in this country. Is it conceivable that the rubber workers in Akron did not know about the Hadfield patent during the fourteen years following its issuance and during which all manufacturers were needing the Killian invention to eliminate hand bead rolling?

This Court in the case of *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 420 held under similar circumstances:

> "* * * if the Deighton patent had been adaptable to the Jones process, it is scarcely possible that its merits should have failed to seize upon the attention of manufacturers,"

The same reasoning applies even more forcefully to the Dutch patent, since it was for a "widely different" purpose and was proved incapable of performing its intended purpose (R. 583-588) and, like the Hadfield patent, had not been used during the time between its issuance and Killian's entry into the field.

The speciousness of this unprecedented rule formulated by the court below is readily demonstrated.

France and certain other countries issue patents without examination and hence in those countries patents may issue on devices which are quite inoperative, such as a perpetual motion machine, or which cannot be made operative by resort to any obvious or any well known mechanical expedient. Even in countries where patent applications are examined, patents may issue on devices which will not operate as described or intended, as witness the Dutch patent in this case.

As the Court below would have it, a prior patent disclosing a device useless either because of inoperativeness,

or inability to perform as intended could serve to invalidate a patent on a device of great commercial use and value simply because the prior patent was not proved to be "generally" or "widely known in the art."

Though petitioner, by its Petition for Remand or Rehearing, stood ready to prove that the Hadfield and Dutch patents were "widely known in the art," that Petition was nevertheless summarily denied.*

By putting on the inventor the burden of *proving general knowledge of a failure,* the Court below relieved respondents of a burden of proof which this Court has consistently placed upon those attacking a patent.

> "A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the presumption has been overcome by convincing evidence of error."
>
> *Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc.,* 293 U. S. 1, 7.

> "Not only is the burden to make good this defense (want of novelty) upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him'."
>
> *Mumm v. Decker,* 301 U. S. 168, 171.

This burden of proof should certainly be no lighter where the defense is based, as here, on mere "paper" patents, the devices of which could not even do what the patents said they were to do.

Had it not relieved respondents from that burden, it is doubtful that the Court below could, on its own reasoning, have reversed the Trial Court.

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* The foregoing rule, and others, newly formulated by the Court below in this case and set out herein, have already been applied generally by the Court below in the case of *Landis Machine Co. et al. v. Parker-Kalon Corp. et al.,* 90 USPQ 129, decided July 11, 1951. Moreover, the Court below, of its own volition, remanded that case for the taking of proof of the very kind which it had refused us leave to take.

(2) The decision of the Court below is in conflict with the decision of the Court of Appeals for the Sixth Circuit on the issue of whether a patent in suit may be invalidated by a "paper" patent which was not conceived, disclosed, adaptable by obvious and well-known expedients, or adapted, to accomplish the ends of the patent in suit.

Since paper patents are almost invariably relied on as defenses in patent infringement suits, it is important that this conflict be resolved by this Court.

A "paper" patent is one which discloses a device that has never been used commercially. The paper patent rule was initiated by this Court in *Carnegie v. Cambria,* 185 U. S. 403, 421-422 and has been followed by this Court in *Williams v. United Shoe Mach. Corp.,* 316 U. S. 364, affirming the decision of the Court of Appeals for the Sixth Circuit, 121 F. (2d) 273, 278, and by other courts including *Hutzler Bros. Co. et al. v. Sales Affiliates, Inc.,* 164 F. (2d) 260, 266 (C. A. 4), and *Wahl v. Andis,* 66 F. (2d) 162, 165 (C. A. 7). The rule was fully and succinctly stated by the Court of Appeals for the Sixth Circuit in the case of *Trabon v. Dirkes,* 136 F. (2d) 24, 26 as follows:

> "We have no doubt that paper patents which precisely disclose the purpose, means, and mechanism for accomplishing the end of a patent in suit, or which may be adapted for that purpose by obvious and common mechanical expedients, may be regarded as anticipatory in that they disclose lack of novelty in an assailed invention. Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 423, 22 S. Ct. 698, 46 L. Ed. 968. But an organization that was neither conceived nor disclosed by the prior inventor, nor adapted by obvious or well-known mechanical expedients, will not convert a prior patent into an anticipation. Topliff v. Topliff, 145 U. S. 156, 12 S. Ct. 825, 36 L. Ed. 658; Gordon Form Lathe Co. v. Walcott Mach. Co., 6 Cir., 32 F. 2d 55. The fact that a prior art device, even though adaptable, was not in fact adapted, strongly indicates that the

changes were not obvious and involve more than mechanical skill. Potts & Co. v. Creager, 155 U. S. 597, 15 S. Ct. 194, 39 L. Ed. 275; Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527."

In the case at bar, the Trial Court cited and adhered to the rule of the *Trabon* case, but the Court of Appeals, in reversing the Trial Court, abrogated that rule in the following terms:

"The phrase 'paper patent' is a mere bit of rhetoric usually employed as a makeweight by judges who wish to support the patent in suit, but are embarrassed by a reference, of an escape from which they are not too confident. It is a meaningless platitude." (R. 826-7.)

Moreover, in modifying, reorganizing and adapting the Dutch patent, admittedly for a "widely different" purpose, to invalidate Patent No. 2,128,827, the Court below has nullified the test long ago announced by this Court in the case of *Seymour v. Osborne,* 11 Wall. 516, 555 and followed more recently in the case of *Carson v. American Smelting & Refining Co.,* 4 F. (2d) 463, 465 (C. A. 9) as follows:

> "*A foreign patent is to be measured as anticipatory not by what might have been made out of it, but by what is clearly and definitely expressed in it.* An American patent is not anticipated by a prior foreign patent unless the latter exhibits the invention in such full, clear and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments."

(B) Important Questions of Patent Law Have Been Decided in a Manner Which is in Conflict With Applicable Decisions of This Court.

(1) The decision here ignores the test of invention based on the standard of something more than could be accomplished by the "mechanic skilled in the art" which is the rule in this Court, and by substituting the standard of something more than could be accomplished by another "inventor," the decision below sets up an impossible standard. IF ALLOWED TO STAND, THE DECISION HERE WOULD INEVITABLY INVALIDATE, IN THE SECOND CIRCUIT, EVERY PATENT REGARDLESS OF ITS MERIT.

That "mechanic skilled in the art" standard has recently been defined by this Court, as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art.'" (citing many cases.) *Sinclair & Carroll Co. v. Interchemical Corporation*, 325 U. S. 327, 330.

The Court below has substituted an *inventor* for that "mechanic skilled in the art." (R. 830.) Moreover that substitution was made and applied *ex post facto* in this case. Paraphrasing this Court's above cited definition, as the Court below would have it, it becomes the rule that it is "an essential requirement for the validity of a patent that the subject matter display 'more ingenuity than the work of an *inventor*.'"

And in so substituting an *inventor* the Court below selected a special kind of mythical *inventor*. That mythical *inventor* must not only be an inventor but he must be a perseverent, active (not a sluggish) "experimenter," "an inventor, bent on adapting" a prior apparatus to the patentee's purposes. (R. 830.) Moreover, that mythical inventor must also be *presumed* to have had the *insight* to

recognize that the prior device *might be adapted* to the purposes of the patent in suit, even though as here, that device was for a "widely different" purpose and could not do even what it was supposed to do, much less accomplish the purpose of the patent in suit. (R. 583-588.)

The Court of Appeals begs the question in assuming, as it does, that "if an inventor wished to supply the market with such articles (prophylactics) and had the Dutch disclosure before him," (R. 830) he would have had the insight even to imagine that the Dutch disclosure could give him any guidance for his "widely different" purpose. *An "inventor" but not a "mechanic skilled in the art" would have such insight;* for this Court has held that:

> "invention consisting rather in the idea that such change could be made, than in making the necessary mechanical alterations." *Hobbs v. Beach,* 180 U. S. 383, 393.

We know of no decision of this Court which even so much as countenances any such substitute for the "mechanic skilled in the art" as a basis for determining invention as against mechanical skill. Obviously, if this new rule is permitted to become the law, patents generally, including patents which this Court has held were pioneer patents, would be held invalid, for practically every patent has some antecedent even though it resembles the patent in suit "only as the anatomy of a corpse resembles that of the living being." *Consolidated Valve Co. v. Crosby Valve Co.,* 113 U. S. 157, 171; 141 U. S. 441, 448.

If this extremely harsh rule is to serve as a precedent, as it unquestionably will, if allowed to stand, then the policy of encouraging invention through the incentive of patents is vitiated. *Patent protection for "improvements" would become a thing of the past, despite the clear wording of the patent statutes* (35 U. S. C. 31, R. S. 4886). Such rule would impel the patent bar to counsel inventors and investors "to foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system." *Graver v. Linde,* 339 U. S. 605, 607.

(2) The decision of the Court below is in conflict with this Court's interpretation of Rule 52(a) of the Federal Rules of Civil Procedure. The pertinent part of that rule is as follows:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 275, this Court said:

> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."

In raising this point we do not suggest that the ultimate conclusion of invention or no invention is a finding of fact; nor do we suggest that conclusions on a slightly subsidiary level with respect to the difficulty or lack of difficulty involved in a given achievement may not involve mixed questions of law and fact. As this Court has made clear, there is a Constitutional and statute-implemented legal concept of "invention." What we do submit is that in patent cases as in other cases there are, subsidiary to the above considerations, extremely important factual issues which can only be explored on the trial level in each case and which, once "determined" on that level, normally set the factual premises for any further pursuit of the particular litigation. This fundamental principle governing appeals—of which Rule 52(a) is a re-affirmation—has always been assumed to work both ways. The discussion which follows is based on that assumption.

The Court below did not rule that the Findings of Fact of the Trial Court were clearly erroneous, nor did it expressly disagree with any of those findings, and yet it *completely nullified them.* It so nullified them by the device of making Findings of Fact incompatible with the findings of

the Trial Court and having no support in the record, as appears from the following consideration of Patent No. 2,128,827.

The Trial Court made Findings of Fact quoted above on pages 11, 12.

The operation of the Dutch disclosure was demonstrated in open Court with supporting testimony, and it was shown that that disclosure, if applied to make prophylactics, would produce a "worthless product" (R. 248-255) as the Trial Court indeed held (R. 812).

Without even attempting to show that the Findings of Fact of the Trial Court were clearly erroneous, the Court below nullified those findings by substituting its own findings as follows:

> "* * * with one exception they are so far alike that the Dutch machine could have been substituted for the patent in suit after changes that certainly could not of themselves sustain a patent." (R. 829.)
>
> "Stop the 'process' at two immersions and a 'prophylactic' results; that, coupled with the mechanical changes that we have mentioned, is the full measure of all that can be attributed to Killian." (R. 830.)

The alleged obviousness of these changes is quite incompatible with the Trial Court's Findings of Fact and wholly contrary to the evidence on which such findings are based.

Patent No. 2,128,827 discloses operations and apparatus for rolling a bead on the open end of the rubber film, curing that film, dusting the resulting article and removing it from the form. *The disclosure of the Dutch patent does not include facilities intended for or capable of performing any of these operations.*

If a stick or form with a film of latex on it were passed through the smoke chamber of the Dutch patent, most of the latex on the end of the form would flow onto the cylindrical part of the form resulting in a "worthless product,"

as found by the Trial Court (R. 812). Moreover, the rubber of the latex on the sticks would be coagulated and would form a sticky coating of uncured, unvulcanized rubber which, if rolled upon itself, in attempted removal from the form, would become a solid doughnut that could not be unrolled (R. 586-588).

In proceeding as it did with respect to both patents in suit, *the Court below failed to comply with either the language or intent of the rule and failed to heed the admonitions of the rule, and of this Court to give due regard to the opportunity of the Trial Court to judge of the credibility of the witnesses.* As in *Graver v. Linde,* the Trial Judge in the present case viewed motion pictures of the patented and the infringing apparatus in operation, observed demonstrations of the prior art and of the patented devices in open Court, heard and saw experts and other witnesses testify and resolved conflicting testimony.

Since this rule 52(a) is Statute law which all other United States Courts of Appeals have heeded* in letter and in spirit, the Court below should be brought into line.

---

* *Bozarjian v. Woods,* 175 F. (2d) 483 (C. A. 1);
Franz v. General Motors, 176 F. (2d) 80 (C. A. 3);
Great Atlantic & Pacific Tea Co. v. Jones, 177 F. (2d) 166 (C. A. 4);
Acadian v. Land, 153 F. (2d) 151 (C. A. 5);
Wallings v. General Industries, 155 F. (2d) 711; (C. A. 6) aff. 330 U. S. 545;
Falkenberg v. Bernard Edward Co., 175 F. (2d) 427 (C. A. 7);
Trico v. Delman, 180 F. (2d) 529 (C. A. 8);
Pointer v. Six Wheel, 177 F. (2d) 153 (C. A. 9);
Davies v. Lahann, 145 F. (2d) 656 (C. A. 10).

(3) The Court below, in disregarding the well-established History Test applied by this Court and other Courts in determining the issue of invention, has misapprehended the purport of this Court's recent patent decisions.

In the opinion below the Court of Appeals for the Second Circuit suggests that this Court has recently rejected what were previously clear legal standards of invention, and indicates that, in a "not to be outdone" mood, it will see to it that what formerly were considered meritorious patents will not be upheld in the Second Circuit from this day. It is submitted that the opinion below in this case, like that in the companion case, *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945, is in this respect a sort of "trial balloon."

The current position of the Court of Appeals is perhaps most clearly expressed in that companion case. Referring to the history of the patents there involved, the Court of Appeals said:

> "* * * certainly in old days that would have told strongly in favor of the patent",

and as to one of the patents there involved, it said:

> "Undoubtedly this would have been held invention in times past but now the climate of opinion has changed to require definite novelty in idea, and not new adaptations of an old idea."

In the case at bar, the Court of Appeals held as to Patent No. 2,128,827, that:

> "Killian is entitled to whatever merit is due to the first person who satisfies a long existing need. Moreover, presumably he designed his machine from the ground up and without suggestion or cue; and we may well agree that, taken as a feat, that displayed enough originality to support a patent." (R. 829.)

Thus, by its own findings, the Court below held that the patent measured up to the test stated by this Court as follows:

"It (the invention) is the result of an inventive act, the birth of an idea and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form." (Citing cases) *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 188.

The present position of the Court below is the result of its repudiation of the very History Test which it helped so greatly to formulate throughout the period from 1908 to 1945 and to which it has frequently said it was committed. The Court below had brought together from many decisions of this Court* the fundamentals of the History Test and tersely stated those fundamentals in *Safety Car Heating and Lighting Co. v. General Electric Co.*, 155 F. (2d) 937, at page 939, as follows:

"In appraising an inventor's contribution to the art, as we have often said, the most reliable test is to look at the situation before and after it appears.

* * * * *

"Courts, * * * had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these

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* *Goodyear Tire & Rubber Co. Inc. et al. v. Ray-O-Vac Co.*, 321 U. S. 275 and the many cases cited therein;
Hildreth v. Mastoras, 257 U. S. 27;
Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45;
Powers-Kennedy Co. v. Concrete Co., 282 U. S. 175;
Altoona Publix Theatres v. Tri-Ergon Corp., 294 U. S. 477;
Detrola Corp. v. Hazeltine Corp., 313 U. S. 259;
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84;
Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U. S. 364;
Universal Oil Co. v. Globe Co., 322 U. S. 471;
Dow Chemical Co. v. Haliburton Oil Well Cementing Co., 324 U. S. 320;
Sinclair & Carroll Co. Inc. v. Interchemical Corp., 325 U. S. 327;
Graver Tank & Mfg. Co. Inc. et al. v. Linde Air Products Co., 336 U. S. 271.

> will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than *a priori* conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions. (citing many cases.)"

The History Test was recently followed and applied by this Court to uphold a patent in *Goodyear Tire & Rubber Co. v. Ray-O-Vac*, 321 U. S. 275, 278 and 279, where this Court cited with approval many of its prior decisions. The History Test is still the rule being applied to uphold patents in this Court. *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.*, 336 U. S. 271.

It will be a great loss to all concerned if this History Test is not kept in full force and effect. Nothing better has ever been devised or is suggested as a substitute.

The Court below apparently believed that this Court very recently repudiated the History Test. There has been no such repudiation as appears from the following history.

Referring to the History Test, the Court below said as recently as November, 1944:

> "* * * we understand that the Supreme Court still countenances that approach. (Goodyear Tire & Rubber Co. v. Ray-O-Vac, 321 U. S. 275, 278, 279, 64 S. Ct. 593):" *Condenser v. Micamold*, 145 F. (2d) 878, 879.

And so, a few months earlier (August 28, 1944), the Court below had held a patent valid and infringed in the case of *Interchemical Corp. v. Sinclair & Carroll Co., Inc.*, 144 F. (2d) 842. There the Court followed and applied the History Test of invention.

On May 25, 1945, this Court reversed the Court below and held the patent invalid (*Sinclair & Carroll Co., Inc. v.*

Interchemical Corp., 325 U. S. 327). It appears that the reason for that reversal was that this Court accepted the Findings of Fact of the District Court and rejected the reasoning of the Court of Appeals which was incompatible with those findings.

Shortly after that reversal, the majority opinion of the Court below held in *Jungersen v. Baden et al.*, 166 F. (2d) 807, 811, as follows:

> "The elements here stressed by plaintiff were present in even stronger form in some of these cases, as witness our view in Interchemical Corp. v. Sinclair & Carroll Co., 2 Cir., 144 F. 2d 842, and that of the Seventh Circuit in Kalo Inoculant Co. v. Funk Bros. Seed Co., 7 Cir., 161 F. 2d 981, each reversed in the recent Supreme Court decisions just cited. *We should heed the admonition of these reversals.*"

On review of that case (335 U. S. 560, 571) the dissenting opinion of Mr. Justice Frankfurter and Mr. Justice Burton quoted from the dissenting opinion of Judge Learned Hand as follows:

> "* * * I confess myself baffled to know how to proceed, if we are at once to profess to apply the system as it is, and yet in every concrete instance we are to decide as though it did not exist as it is. In the case at bar, I can only say that, so far as I have been able to comprehend those factors which have been held to determine invention, and to which at least lip service continues to be paid, the combination in suit has every hall-mark of a valid patent."

and on page 572, Mr. Justice Jackson in his dissenting opinion said:

> "But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this court for striking them down so that the only patent that is valid is one which this court has not been able to get its hands on."

That statement of Justice Jackson applies to the Court of Appeals for the Second Circuit, which has stricken down

every patent where validity was in issue that has come before it during the past five years. This Court, however, within two months after Justice Jackson's statement, *unanimously* sustained a patent in the case of *Graver v. Linde,* 336 U. S. 271, 281.* Mr. Justice Black, with whom Mr. Justice Douglass joined, in his concurring opinion, said:

> "I agree, however, that the facts found here justify the holding that Claims 18, 20, 22 and 23 do show patentable discovery when measured by the standards announced by this Court in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84."

But this *unanimous* decision, *favorable* to a patent and applying the History Test, did not influence the Court below in its interpretation of the standards by which this Court determines the validity of a patent. For, in the instant case, it invalidates patents, which on the standard set in *Graver v. Linde,* should have been upheld.

Evidently the Court below interprets the last two pronouncements of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U. S. 147, and *Crest Specialty v. Trager,* .... U. S. ...., 95 L. Ed. 532 (advance sheets), as *compelling an indiscriminating antipathy to patents* for inventions, good and bad. This is made clear beyond dispute, by the opinion in the companion case of *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945, wherein the Court below said:

> "Plaintiff urges that the climate of opinion is again shifting, citing the opinions in Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271, 339 U. S. 605. But that case dealt specifically with the question of equivalents to show infringement, and later decisions do not support *the plaintiff's reading of directional signals.* Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., *supra;* Crest specialty v. Trager, ... U. S. ....."

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* This Court has sustained no less than four patents in the past ten years.

The final devitalization of the History Test by the Court below has been accomplished by requiring the inventor, as a *sine qua non* of validity, to prove that a prior patent was "generally" or "widely known in the art."

Litigation-wise, let us look at this proposition from the point of view of the parties and the Trial Court. Are there no limitations to the burden which may be imposed on an inventor who turns to the courts for vindication of his rights?

As shown hereinbefore, that requirement is contrary to the rules and the presumptions in this Court and several Courts of Appeals and is based on a judicial assumption without benefit of proof and contrary to fact, and is fundamentally so unsound that it leads to the absurd result that a patent on a device long used industry-wide may be invalidated by a patent that does not anticipate and is for an inoperative and useless thing.

The Court below professes a solicitude to "heed the admonitions" of a previous reversal. The question is whether the Court has "heeded," or whether it has overreacted at the expense of the present and other parties. We suggest that the latter is the case.

The result of following the impossibly high standards set by the Court below is highlighted by the fact that of approximately *fifty (50) patents adjudicated during the past five years in the Court below, not a single claim of a patent was sustained where validity was contested.* According to the Annual Reports of the Commissioner of Patents during the past ten years, over twenty (20) per cent of all patents granted during that time were issued to residents of New York, Connecticut and Vermont, constituting the jurisdiction of the Second Circuit. *It follows that twenty (20) per cent of all United States patents issued cannot be sustained in the Circuit in which their owners live, and the owners of the other eighty (80) per cent cannot obtain redress from infringers in the Second Circuit.*

Clearly the Court below is warping this Court's most recent decisions into a mandate that compels it to invalidate every patent that comes before it, even such patents as the one recently held valid by unanimous decision of this Court.

CONCLUSION AND PRAYER.

The decision of the Court below will inevitably serve as a precedent, if allowed to stand, will encourage and foster piracy of meritorious inventions, will make it impossible to sustain improvement patents which are specifically provided for in the Statute (35 U. S. C. 31; R. S. 4886) and will destroy the incentive to invent. The decision of the Court, if allowed to stand, will, by judicial edict, *nullify the Patent System in the Second Circuit,* with the result that enforcement of patent property rights in the Second Circuit and probably elsewhere, will become a futility.

Wherefore, your petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Second Circuit be reversed, and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

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Aug. 17, 1951.

APPENDIX.

35 U. S. C. 31; R. S. 4886. *Inventions patentable.*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

FILED
SEP 20 1951

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ASHER BLUM,
GEORGE E. MIDDLETON,
New York, New York,
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Subject Index

PAGE

Supplementary Statement 1

Summary of Argument 2

Argument 3

The Bead-Roller Patent 3

The Distributing Patent 6

Presumptions of Knowledge of the Prior Art 11

Paper Patents 12

The Mechanic-Skilled-in-the-Art Test of Invention 12

Findings of Fact, Rule 52 (a) F. R. C. P. 13

The History Test 15

There is No Good Reason Why the Writ Should be Allowed 17

The Petition for a Writ of Certiorari Should be Denied 17

Index of Citations

Cases

PAGE

A. & P. Tea Co. v. Supermarket Corp., 340 U. S. 147 . . 14, 16

Butex Gas Co. v. Southern Steel Co., 123 F. 2d 954 . . . 14
Graver Mfg. Co. v. Linde Co., 336 U. S. 271 14

Hanovia Chemical & Mfg. Co. v. David Buttrick Co., 127 F. 2d 888 14
Home Indemnity Co. of New York v. Standard Acc. Ins. Co., 167 F. 2d 919 14

Interchemical Corp. v. Sinclair & Carroll Co., 144 F. 2d 842 15

Jungersen v. Ostby & Barton Co., 335 U. S. 560 . . . . . 8, 16

Kuhn v. Princess Lida of Thurn & Taxis, 119 F. 2d 704 14

Letcher County v. De Foe, 151 F. 2d 987 14

Miller v. Eagle Manufacturing Co., 151 U. S. 186 6

Old Town Ribbon & Carbon Co. Inc. v. Columbia Ribbon & Carbon Mfg. Co., Inc., 159 F. 2d 379 10
Orvis v. Higgins, 180 F. 2d 537 13

Sales Affiliates v. National Mineral Co., 172 F. 2d 608 14
Sbicca-Del Mac v. Milius Shoe Co., 145 F. 2d 389 14
Scott Paper Co. v. Marcalus Co., 325 U. S. 249 6
Sinclair Co. v. Interchemical Corp., 325 U. S. 327 15

Statutes

R.S. 4886 . . . . . 10, 11, 12
R.S. 4888 . . . . . 3, 9

Rule

Rule 52(a), Federal Rules of Civil Procedure 4, 13, 14

SUPPLEMENTARY STATEMENT.

OF THE TWO PATENTS involved in this suit, the first, Killian No. 1,605,445, November 2. 1926, the "Bead-Roller Patent", *expired eight years ago on November 2, 1943.* Petitioner says that this patent was held invalid by the Court below (Pet. 4), but petitioner is mistaken. The Court of Appeals expressly refrained from holding the patent invalid, being content to hold it not infringed:

> "Thus it becomes possible to decide this action upon the issue of non-infringement . . . . The judgment will be reversed, and the complaint upon the first patent will be dismissed for non-infringement" (R. 827).

The second patent, Killian No. 2,128,827, August 30, 1938, the "Distributing Patent", was held invalid by the Court below for lack of invention over two prior patents. Thus the Court had no need to pass on and did not pass on the defense of non-infringement which had been vigorously urged.

The expired Bead-Roller Patent had been litigated before and held valid and infringed by machines differing in structure from the respondent's accused machine, but the Distributing Patent, held invalid here, had never been litigated before. Yet petitioner writes (Pet. 5):

> "No manufacturer other than the respondent has infringed upon either of these patents without suffering an injunction after trial."

But respondent has *not* infringed upon the Bead-Roller Patent, and no other manufacturer was ever sued for infringing the Distributing Patent, so there has been no trial after which the imagined infringer could have suffered an injunction.

Petitioner writes (Pet. 4):

> "These two Killian patents cover important steps in the manufacture of thin dipped rubber articles, including prophylactics."

But prophylactics are not mentioned in either patent. Both relate to the manufacture of "thin rubber articles, such as rubber balloons, finger cots, nipples, rubber gloves". The machines and methods of neither patent are particularly designed for the manufacture of prophylactics.

Petitioner charges (Pet. 6) that respondent "appropriated these two inventions", thereby assuming infringement and validity and begging the question. Petitioner goes on to say that there is "no suggestion in the Record that the respondents did any developmental work of their own." Even if this were true—which it is not—it would be immaterial. Respondent was not charged with appropriation of trade-secrets or any other form of unfair competition.

The only issues involved are infringement of the long-expired Bead-Roller Patent and validity and infringement of the hitherto unadjudicated Distributing Patent. There is no conflict with any other court as to either validity or infringement.

SUMMARY OF ARGUMENT.

The long-expired Bead-Roller Patent, the first patent in suit, was held not infringed by the Court of Appeals. Validity was not passed on. The accused machine, whose structure was stipulated, was patterned after an expired patent and so could not infringe. There is no conflict.

The second patent in suit, the Distributing Patent, was held invalid as to the claims in issue. These claims cover broadly a method and machine for making balloons, finger cots, nipples and rubber gloves by dipping a form in a

rubber solution, then removing the form and rotating and oscillating it to evenly distribute the liquid rubber before it dries and sets. Both specification and claims fail to meet the requirement of R. S. 4888. The claims in suit were held invalid by the Court below on the ground that they do not define a patentable invention over two prior patents, one disclosing a method and machine for dipping forms in a rubber solution followed by removal and rotation of the forms to distribute the rubber, and the other disclosing a method and machine for making nipples by dipping forms in a rubber solution followed by removal and oscillation of the forms to distribute the rubber.

In answering petitioner's argument that the industry's failure to modify and utilize the structures of the machines of the two prior art patents was evidence that Killian had made an invention, the Court of Appeals pointed out that there was no evidence that the industry knew of those prior art patents and that such knowledge could not be presumed. This is sound law. Although the inexorable provisions of the statute deny to a patentee a monopoly of what was in the prior art, though unknown to him, so that courts sometimes say that a patentee is presumed to know the prior art, there can be no presumption that any particular patent was known to the industry, and if such knowledge is necessary to a patentee's case, he must prove it.

Petitioner criticizes the Court of Appeals for characterizing the phrase "paper patent" as "a mere bit of rhetoric". But the statute denies a patent to an inventor for an "invention patented or described in a printed publication in this or any foreign country before his invention thereof", and there is no requirement that the thing thus patented or described should have been used commercially.

Petitioner has captiously taken the position that the Court of Appeals has substituted an inventor for the man skilled in the art in the standard test of invention, thereby creating an impossible, new test. This is not so.

The Court of Appeals based its findings of non-infringement of the Bead-Roller Patent on a stipulation and a prior patent, and its finding of invalidity of the Distributing Patent on two prior patents, all of which it was as competent to read and understand as the Trial Court had been. In the opinion of the Court of Appeals, the Trial Court's findings on infringement in the one case and on invention in the other were "clearly erroneous". There was nothing improper or unusual in what the Court of Appeals did, and Rule 52 (a) F. R. C. P. does not forbid reversal under such circumstances.

The so-called "History Test" of invention, which petitioner charges the Court of Appeals with repudiating, is not an absolute test and is resorted to only when other tests are unavailing. That the Court of Appeals for the Second Circuit has sustained no patents in recent years proves nothing with respect to the instant case, but may be an indication that that Court is applying the exacting standard of invention which this Court has latterly required of it and of all other federal courts.

ARGUMENT.

THE BEAD-ROLLER PATENT.

KILLIAN, NO. 1,605,445 (R. 611).

The Bead-Roller Patent relates to "a new and novel means for forming an annular bead on the open ends of rubber balloons, finger cots, nipples, gloves and other tubular articles". Forms are first dipped in a rubber solution to form a thin unvulcanized article and then placed on vertical pins on an endless belt. This belt carries the forms into contact with a rotating, slightly inclined, horizontal brush. It also carries them into contact with a belt which, through frictional contact, rotates the forms. Thus the forms are rotated about their vertical axes as they pass along the brush which rolls up the rubber to form beads or rings on the open ends of the finger cots, etc.

All of the claims in suit call for "a rotatable brush" or the like, with emphasis on the "a". The patentee prescribes a single brush.

The invention of the old patent to Hadfield, No. 1,097,-017, May 19, 1914 (R. 770) "relates to machines for making finger-cots and the like and the object thereof is to provide an improved machine for forming ring-beads on the open ends of the finger-cots", which was precisely the object of Killian's invention. Hadfield discloses (see Fig. 4) two adjustable, rotary beading rollers made of yieldable rubber instead of Killian's single beading brush. At the trial, respondent produced and satisfactorily operated a machine made according to the Hadfield patent. This was not done in any prior litigation. Petitioner does not attack the operability of the machine of the Hadfield patent, as it did in prior litigations.

The construction and operation of respondent's accused beading mechanism was stipulated (R. 650) to be correctly shown and described in respondent's Maywald Patent No. 2,353,256 (R. 661). It will be noted from an inspection of Figures 18 and 19 of this patent (R. 670) that respondent used two beading rollers instead of Killian's single beading brush. At the trial (R. 465) it was conceded that under the stipulation respondent "used two beading rolls side by side until after the expiration of the first Killian patent". Petitioner's counsel conceded (R. 521) that when he inspected the accused machine, both beading rolls were "adjusted fairly close at that time", so that both beading rolls operated simultaneously, exactly as in the prior Hadfield patent.

The Court of Appeals, after considering the disclosure of the Bead-Roller Patent, the stipulated structure of respondent's machine, and the machine of the Hadfield patent, reached the conclusion that if the claims of the Bead-Roller Patent were valid they were not infringed. If respondent's two rollers were the equivalent of Killian's single brush, then respondent infringed, but by the same

token Hadfield anticipated. The Court held that respondent's two rollers were not the equivalent of Killian's single brush, thus leaving the claims valid but not infringed. Respondent having availed itself of the two-roller construction of the long-expired Hadfield patent could not possibly infringe Killian's much later patent. *Scott Paper Co.* v. *Marcalus Co.*, 326 U. S. 249.

It is true that the Bead-Roller Patent had been held valid and infringed in earlier suits, but as the Court of Appeals pointed out: "it so happens that in all the earlier actions the infringers used a single brush" (R. 827). It was this that had distinguished Killian *and* the infringers from Hadfield with his two soft rubber rollers. But respondent like Hadfield, also used two rubber rollers. Thus petitioner finds itself confronted with a dilemma from which there is no escape. "That which infringes if later, anticipates if earlier". *Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, 203.

Here we have a long-expired patent which the Court of Appeals, applying old and well established criteria, found not to have been infringed by respondent's machine. There is no conflict; no new questions of law are presented or old ones wrongly decided; and no one other than the immediate parties has the slightest interest in the outcome of the litigation. To ask this Court to review the decision below is to impose upon its time and patience.

THE DISTRIBUTING PATENT.

KILLIAN, NO. 2,128,827. (R. 617).

"This invention relates to the manufacture of articles by what is commonly known as the dipping process * * *." And "it particularly relates to apparatus for completely producing thin dipped rubber articles from liquid latex or rubber cement * * *". The specification then goes on to say that "The invention is particularly adapted for

use in the manufacture of thin rubber articles such as rubber balloons, finger cots, nipples, rubber gloves . . ." (p. 1, col. 1, ls. 1-20).

One of the objects recited is to

> "provide a new apparatus and a new method whereby a very short period of time need be allowed to permit the surplus rubber to drain from the form and which will evenly distribute a large amount of the usual drip over the form thereby providing a coating of greater thickness at each dipping; one dipping being sufficient for articles of ordinary thickness" (p. 1, col. 2, ls. 11-18).

In achieving this object Killian moves his dipped form about, tilting it and rotating it so as to get an even distribution of the rubber on the form before it dries and sets. The machine of the patent comprises an endless conveyor on either side of which are pivotally mounted a series of rotatable forms (see Figs. 1 and 10). The conveyor carries the forms through dipping tanks of rubber solution, and the machine rotates and tilts them.

Much was made in the argument below of the nature of the articles, prophylactics, and their extreme thinness, and the use of latex as distinguished from rubber cement, and this argument seemed to have impressed the District Court. But the patent itself, although relating to the manufacture of thin rubber articles, states quite definitely what is meant by thin rubber articles: "such as rubber balloons, finger cots, nipples, rubber gloves . . .". Prophylactics are not even mentioned. And all through the specification the patent refers to "liquid latex or rubber cement" as obvious equivalents—which they are. Latex is the sap of the rubber tree. It consists of minute globules of rubber suspended in water and when the water is evaporated a residue of dry rubber remains. Rubber cement is rubber dissolved in naphtha. In view of these

facts petitioner's attempt to limit the patent to a particular product, a prophylactic, made from latex must fail. *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560.

As we shall show presently, it had long been known in the art of manufacturing thin rubber articles by the dipping process that, in order to insure the formation of a uniform film and prevent the formation of a thick spot at the end of the article, it was necessary to tilt the form back and forth after dipping. Conceivably, Killian might have discovered the optimum conditions for producing the best results by correlating amplitude and time of oscillation, speed of rotation, quality of the rubber solution, atmospheric conditions and temperature. However, there is not a word in the Killian patent as to the amplitude, frequency and duration of the oscillations, the temperature of the forms, or the viscosity of the rubber cement solution or latex. As for the speed of rotation, Killian says that it would depend upon the nature of the goods (p. 5, col. 2, ls. 53-63).

This ambiguity in the specification is reflected in the claims in suit. Claim 14, for example, reads as follows:

> "That method for making dipped rubber articles directly from liquid latex or the like which comprises passing a form through a body of latex, said form being extended into said body with its axis at an angle to the surface thereof, passing said form out of said body of latex and thereafter simultaneously rotating said form about its axis and oscillating said form between positions in which its axis extends at angles above and below the horizontal until the film of rubber deposited on the form has set."

The apparatus claims are even worse, claim 5, for example reading as follows:

> "In apparatus of the class specified, a conveyor arms projecting therefrom, a form mounting membe

hingedly mounted on each arm and forms secured to said mounting member."

These are among the claims held valid by the District Court and invalid by the Court of Appeals. The Distributing Patent fails to meet the requirements of R. S. 4888.

It had long been known in the art of manufacturing rubber articles by the dipping process that movement of the form after dipping was necessary to distribute the liquid rubber. A Dutch patent, No. 2,002, April 25, 1917 (R. 764), discloses a machine for making rubber balls of latex by means almost identical with those disclosed by Killian. After pointing out the differences in purpose of the two machines, the Court of Appeals went on to say (R. 829):

> "Nevertheless, with one exception they are so far alike that the Dutch machine could have been substituted for the patent in suit after changes that certainly could not of themselves sustain a patent."

The one exception was that Killian added:

> "the feature that, after a 'form' had been dipped in its bath of latex and had been raised back again to horizontal, it was raised, still rotating, above the horizontal, so as to insure a more uniform spread of latex. The Dutch patent did not disclose that step and did not need to, because uniformity of distribution was no part of its aim."

But uniformity of distribution *had* been the aim of one Mitzel who was granted patent No. 1,365,528 on January 11, 1921 (R. 785). Mitzel was making nipples by dipping forms in a bath of rubber solution and then, on removal, inverting and reverting them to secure uniformity of distribution of the liquid rubber, or, as Mitzel put it "to overcome any tendency of the solution to flow downward and mass at an end of the form" (p. 2, col. 1, ls. 34-38).

The Dutch patent disclosed dipping and rotation; Mitzel disclosed dipping and oscillation. As the Court of Appeals said (R. 830):

> "had an inventor, bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal resulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed.
>
> "The case therefore comes down to this: How much insight was required to observe that the Dutch machine could be used for the new purpose. That insight once achieved, the necessary adaptations were easily within the reach of ordinary perseverance."

In short, the most that Killian did was to modify the Dutch machine, as taught by Mitzel, and use it for a new purpose.

But patents (other than design and plant patents) are granted under the statute, R. S. 4886, only for

> "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof".

A valid patent cannot be granted for a new use of an old machine. Many cases to this effect in various circuits are collected in *Old Town Ribbon & Carbon Co., Inc.* v. *Columbia Ribbon & Carbon Mfg. Co., Inc.*, 159 F. 2d 379, where the Second Circuit, summing up at page 382, states that a new use, "can never be patentable".

Petitioner refers (Pet. 21) to an alleged operation of the Dutch disclosure, citing pages 248-255 and page 812 of the Record. This reference is incorrect. There never was any operation of a model of the Dutch machine. These parts of the record refer to a test of Plaintiff's Exhibit 22,

which is a model of a hand-operated machine resembling the machine of Figure 15 of the Killian Distributing Patent.

PRESUMPTIONS OF KNOWLEDGE OF THE PRIOR ART.

In seeking to avoid the anticipatory effect of Hadfield, the Dutch patent and Mitzel, petitioner, pointed out to the Court of Appeals that none had made any impression on the art. Surely, said petitioner, the art would have utilized the teachings of the Hadfield, Dutch and Mitzel patents if, in fact, those patents had had anything to teach. But the Court of Appeals rejected this argument, pointing out (R. 831) that, although a patentee is chargeable with knowledge of all that had gone before,

> "Yet when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, he must appraise the art's inaptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

The Court said that, in the case of both the Hadfield and the Dutch patents, it should have to be satisfied that they had been widely known in the art before it could credit Killian with an inventor's perspicacity. This is certainly sound law. There is obviously no presumption that an obscure Dutch patent—or any other patent for that matter—was known to the workers in this art. When it comes to a patentee, however, an entirely different situation is presented. Although Courts are fond of saying that a patentee is presumed to know the prior art, this is merely a figure of speech. A patentee's rights are defined by R. S. 4886. He may not patent an invention "patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof,

or more than one year prior to his application". It is quite immaterial that he did not know of these prior patents or publications; hence the alleged "presumption" that he did.

PAPER PATENTS.

The Court of Appeals characterized the phrase "paper patent" as "a mere bit of rhetoric" and "a meaningless platitude" (R. 826, 827). Petitioner claims that by thus destroying the category of "paper patents" the Court below has created a conflict with the Court of Appeals for the Sixth Circuit. Petitioner defines a "paper patent" as "one which discloses a device that has never been used commercially" (Pet. 16). Petitioner may be confusing the anticipatory effect of a prior public use with that of a prior patent, but R. S. 4886 clearly distinguishes between them. The statute denies a patent to an inventor for an invention "patented or described in a printed publication in this or any foreign country, before his invention or discovery thereof". There is no requirement that the thing previously patented or described should have been "used commercially". Neither the Sixth Circuit nor any other has ever held to the contrary.

THE MECHANIC-SKILLED-IN-THE-ART TEST OF INVENTION.

Petitioner claims that the Court of Appeals has substituted another inventor for the man skilled in the art in the old test of invention, and that under this new rule it is "an essential requirement for the validity of a patent that the subject matter display 'more ingenuity than the work of an *inventor*' " (Pet. 18). Petitioner evolves this paradox from a sentence in the opinion below (R. 830) quoted earlier in this brief:

> "Nevertheless, had an inventor, bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal re-

> sulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed."

It is clear enough that Judge Learned Hand, whose language this is, intended by "inventor" to designate only an "experimenter", as in fact he refers to him later in the quoted sentence. Petitioner is indeed hard pressed for arguments if it must indulge in this sort of quibble.

FINDINGS OF FACT; RULE 52 (a) F. R. C. P.

Like all litigants who have won in the trial court, petitioner holds the findings of that court sacrosanct, relying upon that part of Rule 52 (a) which declares that "Findings of fact shall not be set aside unless clearly erroneous". The Court of Appeals for the Second Circuit is well aware of the rule and understands its meaning. In *Orvis* v. *Higgins,* 180 F. 2d 537, 539, discussing Rule 52 (a) it said:

> "Where a trial judge sits without a jury, the rule varies with the character of the evidence: (a) If he decides a fact issue on written evidence alone, we are as able as he to determine credibility, and so we may disregard his finding. (b) Where the evidence is partly oral and the balance is written or deals with undisputed facts, then we may ignore the trial judge's finding and substitute our own, (1) if the written evidence or some undisputed fact renders the credibility of the oral testimony extremely doubtful, or (2) if the trial judge's finding must rest exclusively on the written evidence or the undisputed facts, so that his evaluation of credibility has no significance. (c) But where the evidence supporting his finding as to any fact issue is entirely oral testimony, we may disturb that finding only in the most unusual circumstances."

The courts of appeals for other circuits have uniformly applied the rule as so defined: that in non-jury cases, where the evidence is largely documentary or physical or not in dispute (as were the patents and the models before the District Court here), as distinguished from conflicting oral testimony, the appellate court is as competent to review and interpret the evidence as was the trial court and is not precluded from so doing by Rule 52 (a).*

Here the Trial Court found that Killian, in his Distributing Patent, had made an invention over the Dutch patent and Mitzel. The Court of Appeals after considering the same documentary evidence found that he had not, obviously concluding that the findings of the Trial Court had been "clearly erroneous". Petitioner relies heavily upon the decision of this Court in *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 which restated the "two-court rule". But later this Court itself in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 refused to be bound by that rule where it appeared that a less exacting standard of invention had been used by the two courts than that required. Aside from the obvious fact that the two-court rule is not applicable here, it is plain that the Court of Appeals reversed the District Court because the latter had used the wrong standard of invention in finding the claims in suit valid.

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* *Hanovia Chemical & Mfg. Co.* v. *David Buttrick Co.*, 127 F. 2d 888, 891 (1 Cir.).
Kuhn v. *Princess Lida of Thurn & Taxis*, 119 F. 2d 704, 705, 706 (3 Cir.).
Butex Gas Co. v. *Southern Steel Co.*, 123 F. 2d 954, 955 (5 Cir.).
Letcher County v. *De Foe*, 151 F. 2d 987, 990 (6 Cir.).
Sales Affiliates v. *National Mineral Co.*, 172 F. 2d 608, 613 (7 Cir.).
Sbicca-Del Mac v. *Milius Shoe Co.*, 145 F. 2d 389, 395, 396 (8 Cir.).
Home Indemnity Co. of New York v. *Standard Acc. Ins. Co.*, 167 F. 2d 919, 930 (9 Cir.).

In the case of the Bead-Roller Patent the Trial Court found that respondent had followed Killian and not Hadfied and so infringed. This finding was based on a consideration of the two patents and a stipulation as to the construction and operation of the accused machine. The Court of Appeals, with the same documentary evidence before it, found that respondent had followed Hadfield and not Killian and so did not infringe. The reversal was clearly proper under the Rule.

THE HISTORY TEST.

Petitioner concludes its petition with a salute to what it calls the "History Test" of invention, which it says the Court of Appeals has now repudiated. But the history test, or the test of the long-felt want, with its concomitant, commercial success, was never an absolute test and is at best applied only when invention is in doubt. If the Court of Appeals for the Second Circuit has latterly shown less enthusiasm for this test than formerly it is only because of pointed admonitions from this Court. In *Interchemical Corp.* v. *Sinclair & Carroll Co.*, 144 F. 2d 842, cited by petitioner (Pet. 25), the Court of Appeals had applied the test saying (843):

> "We think the record clearly establishes that the trade had long striven to secure an ink that would maintain its consistency on the rollers until the web was imprinted and would then instantly dry on application of a sufficient amount of heat but had never succeeded in obtaining such an ink until Gessler made his invention."

The Court thereupon held the claims in suit valid and infringed, reversing the District Court which had held them invalid and not infringed. This Court granted certiorari and in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327,

335, reversed the Court of Appeals, holding the claims invalid for lack of invention. In short, the history test was unavailing to save a patent when what the patentee had done was "no more ingenious than selecting the last piece to put into the last opening in a jig-saw puzzle". The commercial success of a patented thing is part of its history. Yet only as recently as in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 153, this Court reiterated the rule that "commercial success without invention will not make patentability". No, the history test is not wholly reliable.

Petitioner writes (Pet. 27) that:

> "Evidently the Court below interprets the last two pronouncements of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, and *Crest Specialty* v. *Trager*, —— U. S. ——, 95 L. Ed. 532 (advance sheets) as *compelling an indiscriminating antipathy to patents* for inventions, good and bad."

We submit that the antipathy of the Court below is only for patents for *bad* inventions, that is to say for patents that claim no invention at all. It may be true that the Court of Appeals for the Second Circuit has sustained no patent during the past five years but until we know what the invalidated patents claimed, we can draw no intelligent conclusion from the mere fact of their invalidation. Maybe this Court would have invalidated them too; as a matter of fact, in the only case that went up, *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, it did just that. Even assuming *arguendo* that the Court below has erred in other cases, that cannot concern us here, where the only question involved is whether that Court's decision in the *instant* case warrants this Court's review.

THERE IS NO GOOD REASON WHY THE WRIT SHOULD BE ALLOWED.

This is just another patent suit in which the defeated litigant seeks redress from this Court for no good reason except that it would like to win. One of the patents in suit has long since expired and whether or not it was infringed by respondent is of no possible concern to anyone but the parties to this litigation. The claims in suit of the other patent were held invalid for lack of invention over the prior art. This is the first and only time this patent has been adjudicated. There is no conflict as to either patent and the case presents no questions requiring answer by this Court.

THE PETITION FOR A WRIT OF CERTIORARI SHOULD BE DENIED.

Respectfully,

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